APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/507,941	02/22/2000	Masato Ochiai	35.C14278	2960

5514   7590   01/14/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
ENGLAND, DAVID E

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 01/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- Th MAILING DATE of this communication appears on the cover sh et with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*17 August 2004*</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1, 2, 4, 6, 8 – 10, 12, 13, 15, 17, 19 – 21, 34 and 45 – 49* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 4, 6, 8 – 10, 12, 13, 15, 17, 19 – 21, 34 and 45 – 49* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1, 2, 4, 6, 8 – 10, 12, 13, 15, 17, 19 – 21, 34 and 45 – 49 are presented for

examination.

Claim Rejections - 35 USC § 102

2.   The text of those sections of Title 35, U.S. Code not included in this action can be found

in a prior Office action.

3.   Claims 1, 2, 4, 5, 12, 13, 15, 34 and 47 – 49 are rejected under 35 U.S.C. 102(e) as being

anticipated by Beser U.S. Patent No. 6189102.

4.   Referencing claim 1, as interpreted by the Examiner, Beser teaches a network apparatus

comprising:

5.   a receiving unit adapted to receive data from a network by using a predetermined

protocol, (e.g. col. 14, line 38 – col. 16, line 35);

6.   a detecting unit adapted to receive a predetermined value in a packet header of the data

received by said receiving unit, the packet header being provided for the predetermined protocol,

(e.g. col. 14, line 38 – col. 16, line 35, *"HOPS 116, XID 118, FLAGS 122, TLV"*); and

7.   a setting unit adapted to set a destination logic address of the received data as a logic

address of said network apparatus in a case where the predetermined value is detected by said

detecting unit and a destination physical address of the received data and a physical address of

said network apparatus are the same, (e.g. col. 14, line 38 – col. 16, line 35, *"BOOTP"*).

8.   Referencing claim 2, as interpreted by the Examiner, Beser teaches in a case where the

destination logic address of the received data and the logic address of said network apparatus

differ, the destination physical address of the received data and the physical address of said

network apparatus are the same, and the predetermined value is detected by said detecting unit,

said setting unit sets the destination logic address of the received data as logic address of said

network, (e.g. col. 14, line 38 – col. 16, line 35, *"BOOTP"*).

9.   Referencing claim 4, Beser said physical address is a media access control address, and

the logic address is an Internet protocol address, (e.g. col. 14, line 38 – col. 16, line 35 & col. 18,

line 49 – col. 19, line 16).

10.   Claims 12, 13, 15, 34 and 47 – 49 are rejected for similar reasons as stated above.

11.   Claims 45 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Nixon et al.

U.S. Patent No. 6266726 (hereinafter Nixon).

12.   Referencing claim 45, Nixon teaches a network apparatus comprising:

13.   a receiving unit adapted to receive data from a network by using a predetermined

protocol, (e.g. col. 25, lines 31 – 55, *"Cards, Ports and devices"*);

14.   a detecting unit adapted to receive a predetermined value in a packet header of the data

received by said receiving unit, the packet header being provided for the predetermined protocol;

(e.g. col. 26, line 24 – col. 27, line18, *"UDP datagram"*); and

15.   a setting unit adapted to set a factory-based value in a case where the predetermined

value is detected by said detecting unit and a destination physical address of the received data

and a physical address of the network apparatus are the same, (e.g. col. 26, line 24 – col. 27,

line18, *"UDP datagram, default primary address"*).

16.   Reverencing claim 46, Nixon teaches said setting unit sets the factory-based value if the

destination physical address of the received data and the physical address of said network

apparatus are the same and the predetermined value is detected by said detecting unit, (e.g. col.

26, line 24 – col. 27, line18, *"UDP datagram, default primary address"*).

Claim Rejections - 35 USC § 103

17.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

18.   Claims 6, 8 – 10, 17 and 19 – 21 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Beser (6189102) in view of Anderson et al. (5850388) (hereinafter Anderson).

19.   Referencing claim 6, Beser does not specifically teach the received data is an ICMP echo

message by an ICMP protocol and the predetermined value indicates a data length of the ICMP

echo message. Anderson teaches the received data is an ICMP echo message by an ICMP

protocol and the predetermined value indicates a data length of the ICMP echo message, (e.g.

col. 12, lines 22 – 56 & col. 20, line 54 – col. 21, line 30). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to combine Anderson with Beser

because it would be more efficient for a system to not have to shut down an end system and turn

back on to receive a new IP address as with the functionality of BOOTP. Using an ICMP echo

would allow a user to keep the end system on and receive a new IP address with out the burden

of turning the end system off. Furthermore, utilizing a data length, sometimes known as a

"checksum" or "CRC", allows the end system to check for errors in the packet if the data length

is not to a predetermined length.

20.   As per claim 8, Beser does not teach the predetermined value indicates a TTL value of

the received data. Anderson teaches the predetermined value indicates a TTL value of the

received data, (e.g. col. 21, line 59 – col. 22, line 24). It would have been obvious to one of

ordinary skill in the art at the time the invention was made to combine Anderson with Beser

because it is more efficient for a packet to have a TTL field in a packet so if the packet is taking

too long to be transmitted through the Internet the packet could be dropped and aid in congestion

control in a network.

21.   Claims 9, 10, 17 and 19 – 21 are rejected for similar reasons stated above.

Response to Arguments

22.   Applicant's arguments filed 08/13/2004 have been fully considered but they are not

persuasive.

23.   In the remarks, Applicant argues in substance that nothing has been found in Beser that

would teach or suggest setting the destination logic address of the received data as the logic

address of the network apparatus in a case where (a) the predetermined value is detected by the

detecting unit and (b) a destination physical address of the received data and a physical address

of the network apparatus are the same, as recited in Claim 1.

24.   As for part 1, Examiner would like to draw the Applicant's attention to the claim

language of claim 1. In which the Applicant does not specifically define in the claim what the

"predetermined value", "detecting unit" and "setting unit". Furthermore, the claim language does

not specifically state what or where the destination or source address is coming from and what

device the physical and logic addresses are addressed to, which would make it ambiguous as to if

the device that is receiving the packet is the destination or, the source of the packet that is

responding to an acknowledgement from another device or setting the logic address from a

response to a query. The Applicant is advised to look over the RFC-951 and PFC-1542 the Beser

has incorporated as a reference in the section the Examiner has cited, which states "This RFC

describes an IP/UDP bootstrap protocol (BOOTP) which allows a diskless client machine to

discover its <u>own IP address</u>". Therefore, the act of having the BOOTP protocol set the IP address

of a device from the physical address that is in a database reads on the claim language.

25.   In the remarks, Applicant argues in substance that nothing has been found in Anderson et

al. that would teach or suggest setting a destination IP address of the received ICPM echo

message as an IP address of the network apparatus if (a) the data length has a specific value and

(b) a destination MAC address if the received ICMP echo message and a MAC address of the

apparatus are the same, as recited in Claim 9.

26.   As for part 2, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they

amount to a general allegation that the claims define a patentable invention without specifically

pointing out how the language of the claims patentably distinguishes them from the references.

27.   Examiner would also like to draw the Applicant's attention to the above reasoning in part

one of the Examiner's Response to Arguments. In which the same language appears in claim 9

and for the same reasoning claim 9 is still rejected for reasons stated above. Furthermore, the

Applicant does not state in the claim language of claim 9 where or what the data length is

suppose to be or which part of the packet the data length is suppose to be, (i.e. it could be the

CRC which is the check sum of the packet, which is well known in the art that if the CRC does

not have a specific number in it the data packet does not add up correctly which could mean that

the data length has an error and the packet is bad.

28.   In the remarks, Applicant argues in substance that nothing has been found in Nixon et al.

that would teach or suggest a network apparatus setting a factory-based value in a case where (a)

the predetermined value is detected by the detecting unit and (b) a destination physical address of

the received data and a physical address of the network apparatus are the same, as recited in

Claim 45.

29.   As for part 3, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they

amount to a general allegation that the claims define a patentable invention without specifically

pointing out how the language of the claims patentably distinguishes them from the references.

30.   The Examiner would like to draw the Applicant's attention to the above responses to the

Applicant's remarks which all have similar claim language and issues that are incorporated

herein as reference. The Reference of Nixon teaches a MAC address, which it is well known in

the art that at the time of manufacture, a MAC address can be set on a network device as a

backup address if the device has not yet been installed into a network and does not have an IP

address. Therefore, with the above responses to Applicant's arguments, Nixon reads on the

Applicant's broad claim language.

Conclusion

31.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

32.   Bill Croft, Internet RFC/STD/FYI/BCP Archives, http://www.faqs.org/rfcs/, September

1985, RFC 951.

33.   W. Wimer, Internet RFC/STD/FYI/BCP Archives, http://www.faqs.org/rfcs/,October

1993, RFC 1532.

34.   W. Wimer, Internet RFC/STD/FYI/BCP Archives, http://www.faqs.org/rfcs/, October

1993RFC 1542.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to David E. England whose telephone number is 571-272-3912.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                                                        David E. England
                                                        Examiner
                                                        Art Unit 2143

De

                                                        DAVID WILEY
                                                SUPERVISORY PATENT EXAMINER
                                                    TECHNOLOGY CENTER 2100